REMARKS

This Application has been carefully reviewed in light of the Office Action mailed September 5, 2003. At the time of the Office Action, Claims 1-44 were pending in this patent application. The Examiner rejects Claims 1-44. Claims 1, 21, and 26 have been amended to make stylistic changes and to more clearly claim what the inventor believes to be the invention. Applicants do not admit that these amendments were made as a result of any cited art. Applicants respectfully request reconsideration and favorable action in this case.

Section 102 Rejection

The Examiner rejects Claims 1-6, 13, and 19-24 under U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,535,294, issued to Arledge, Jr. et al. ("*Arledge*"). Applicants respectfully request reconsideration of this rejection of Claims 1-6, 13, and 19-24.

Regarding independent Claim 1, Applicants respectfully submit that *Arledge* does not disclose, teach, or suggest "canceling the custom order after processing of the custom order is initiated and before the custom order is scheduled for manufacturing if a cancel request is received from the user," as recited in amended Claim 1. *Arledge* merely discloses a system that allows for the cancellation of an order by an intermediary retailer before the order is processed. Specifically, *Arledge* discloses a "system and method for preparing a desired quantity of customized printed products, wherein an end-user thereof connects to, communicates with and submits an order to an anonymous wholesaler print shop, directly, via a subscribing retailer website." (Column 2, lines 55-59). "Using the browser and conventional Internet addressing, the end-user connects to a subscribing commercial printed products retailer web server computer hosting a retailer web site on the World Wide Webb, whereat the end-user is presented with a button to initiate preparation and ordering of customized printed products." (Column 3, lines 22-28). As an example, an end user may visit a retailer's website to buy printed business cards. To initiate an order, the end user clicks on a button to prepare the custom business cards.

"Upon selecting the button, the end-user's browser is transferred from the retailer web site to an anonymous printed products wholesaler web server computer hosting a wholesaler web site on the World Wide Web." (Column 3, lines 28-32). "Once connected to the wholesaler web server computer, the end-user logs in to a printed products preparation system located, operated and managed on and by the wholesaler web server computer."

(Column 3, lines 40-43). "Upon entering all desired design, layout, shipping and billing information, the end-user submits the order to the wholesaler, at which point the preparation system automatically dockets a new order on a new order queue of the retailer's dealer account." (Column 4, lines 9-13). Thus, although it appears to the user that the user is still visiting the retailer's website to make the purchase of business cards, the user has actually been routed to a wholesaler's website to complete the order. The order is then put on the retailer's account.

"The preparation system also sends an e-mail to the subscribing retailer web server computer, instructing the retailer to log in to the retailer's dealer account to review the order information for all pending end-user orders. The retailer connects to the wholesaler's web site . . . and logs in to the retailer's dealer account, where the retailer may review the order information . . . process the billing instructions, accept the order, hold the order or cancel the order." (Column 4, lines 16-27). "The retailer reviews the order information and either submits the order into production (by selecting the "Submit" hypertext button 423), suspends the order pending further action (by selection the "Hold" hypertext button 424) or cancels the order completely (by selecting the "Cancel" hypertext button 425)." (Column 21, lines 8-14). Thus, the order is not submitted for manufacturing until the retailer reviews and accepts the order. "Once the retailer accepts the order, the file containing the design and layout information is transferred internally from the wholesaler web server computer to a workflow management server computer system located in the wholesaler's print processing plant. The order is then processed and printed by the wholesaler's printing equipment, as managed by the workflow management server computer system." (Column 4, lines 27-34). Thus, *Arledge* merely discloses a system that allows for the cancellation of an order *before* processing of the order is initiated. The processing of the order is initiated only after the order is accepted by the retailer. Additionally, the system of *Arledge* allows the cancellation of the order by the intermediary retailer rather than the end user. For at least these reasons, *Arledge* does not disclose, teach, or suggest "canceling the custom order after processing of the custom order is initiated and before the custom order is scheduled for manufacturing if a cancel request is received from the user," as recited in amended Claim 1.

Additionally, Applicants respectfully submit that a modification of the system of *Arledge* to allow for the cancellation of an order by an end user would both "change the principle of operation" of *Arledge* and render *Arledge* "unsatisfactory for its intended

purpose." If a "proposed modification would render the prior invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification." MPEP §2143.01. Also, if a "proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious." MPEP §2143.01.

As discussed above, *Arledge* provides for a system and method for preparing customized printed products, "wherein an end-user thereof connects to, communicates with and submits an order to an anonymous wholesaler print shop, directly, via a subscribing retailer web site." (Column 2, lines 55-59). The retailer's ability to cancel the order before the order is processed gives the intermediary retailer the opportunity to "process the billing instructions provided by the end-user . . . If, however, the retailer is unable to receive payment for the products, he/she may suspend the order, pending the end-user's payment for the order using alternative payment means, or may cancel the order." (Column 21, lines 16-25). Because the system of *Arledge* is designed to allow the retailer to cancel the transaction when the retailer determines the retailer is unable to obtain payment, a modification of *Arledge* to include the claimed features would impermissibly change the principle of operation disclosed in *Arledge*. Additionally, a modification of the system of *Arledge* to include the claimed features would defeat the intended purpose of the "cancel" function as disclosed in *Arledge*, which is to protect the retailer.

For at least these reasons, Applicants respectfully request reconsideration and allowance of Claim 1.

Claims 2-6, 13, and 19-20 depend from Claim 1 and recite further limitations that are patentably distinct from *Arledge*.

Regarding Claim 13, Applicants respectfully submit that *Arledge* does not disclose, teach, or suggest "receiving a lead request message incorporating lead data and product configuration data submitted by the user, the lead data identifying the online user as a potential customer," as recited in Applicants' Claim 13. *Arledge* merely discloses that upon "selecting the "Dealer Login" hypertext button 401 on the wholesaler's website, the retailer is presented with a dealer "home" screen 405 having one or more hypertext action buttons displayed thereon." (Column 20, lines 22-26). One of the buttons displayed to the retailer

includes a "Place Order" hypertext button 407 "which transfers the retailer to a portion of the wholesaler's web site through which the retailer may order wholesale printed products, either with or without customization, for retail sale in the retailer's store." (Column 20, lines 30-35). Another button displayed to the retailer includes "Check Order Status" hypertext button 408 "which transfers the retailer to a portion of the wholesaler's web site through which the retailer may inquire as to the status of any orders placed using the hypertext buttons 407." (Column 20, lines 36-40). Thus, the "Check Order Status" hypertext button 408 allows a *retailer* to check on the status of an already placed and processed order. Accordingly, *Arledge* does not disclose, teach, or suggest "receiving a lead request message incorporating lead data and product configuration data submitted by the user, the lead data identifying the online user as a potential customer," as recited in Applicants' Claim 13. For at least these reasons, Applicants respectfully request reconsideration and allowance of Claims 2-6, 13, and 19-20.

Regarding independent Claim 21, *Arledge* does not disclose, teach, or suggest "an order bank operable to . . . cancel the custom order after processing of the custom order is initiated and before the custom order is scheduled for manufacturing if a cancel request is received from the user," as recited in Applicants' amended Claim 21. For reasons similar to those discussed above with regard to Claim 1, *Arledge* is limited to nothing more than a system that allows for the cancellation of an order by an intermediary retailer before an order is processed. For at least these reasons, Applicants respectfully request reconsideration and allowance of Claim 21, together with dependent Claims 22-24 that depend from Claim 21.

Section 103 Rejection

The Examiner rejects Claims 7-12, 25-37, and 39-40 under U.S.C. § 103(a) as being unpatentable over *Arledge* in view of U.S. Patent No. 6,041,310, issued to Green et al. ("*Green*"). Applicants respectfully request reconsideration of this rejection of Claims 7-12, 25-37, and 39-40.

Regarding independent Claim 26, Applicants respectfully traverse the Examiner's position. Claim 26 recites, in part, "receiving a custom order message . . . submitted by an online user . . . storing the order data, user data and vehicle configuration data into a buyer database . . . processing the custom order . . . entering the custom order and its associated data into an

order bank to schedule the specified vehicle for manufacturing . . .canceling the custom after processing of the custom order is initiated and before the specified vehicle is scheduled for manufacturing if a cancel request is received from the user . . . generating an order confirmation message and sending the order confirmation message to the user." Nowhere does the *Arledge-Green* combination disclose, teach, or suggest these aspects of the claimed invention.

For reasons similar to those discussed above with regard to Claims 1 and 21, the system of *Arledge* does not disclose the features and operation recited in Applicants' Claim 26. Rather, *Arledge* merely discloses a system that allows for the cancellation of an order by an intermediary retailer before the order is processed. Thus, the recited features are completely absent from the online system disclosed in *Arledge*. Because this deficiency is not cured by *Green*, the combination of references cannot be said to disclose, teach, or suggest "canceling the custom after processing of the custom order is initiated and before the specified vehicle is scheduled for manufacturing if a cancel request is received from the user," as recited in Applicants' Claim 26.

For at least these reasons, and for those stated above with respect to Claims 1 and 26, Applicants respectfully request reconsideration and allowance of Claim 26. Claims 7-12 and 25 depend from Claims 1 and 21, respectively, shown above to be allowable. Claims 27-37 and 39-40 depend from Claim 26 shown above to be allowable.

The Examiner rejects Claims 14-18 under 35 U.S.C. § 103(a) as being unpatentable over *Arledge* in view of U.S. Patent No 5,231,567, issued to Matoba et al. ("*Matoba*"). Applicants respectfully request reconsideration of this rejection of Claims 14-18.

First, Applicants have shown above that *Arledge* does not recite each and every claim limitation of Claims 1 and 13, from which Claims 14-18 depend. Thus, Claims 14-18 are allowable for at least this reason.

Second, Applicants continue to submit that in rejecting Claims 14-18 the Examiner has improperly performed what amounts to a "keyword rejection." Applicants traverse the Examiner's rejection at least because it appears that the Examiner simply performed a keyword search to locate the word "lead" in the text of *Matoba* and then uses this word to reject those portions of Claims 14-18 that happen to also include the word "lead."

Significantly, however, the keywords are often taken out of context and do not teach, suggest, or disclose the claimed aspects of the present invention.

As acknowledged by the Examiner (Office Action, page 9) "lead" as disclosed in *Matoba* refers to "lead time," i.e., "the number of days estimated as demanded for completion of a product to be manufactured." (Background) Specifically, *Matoba* discloses a system "capable of automatically determining a lead time in consideration of product specifications, appointed date of delivery and production process states and capable of creating a production schedule on a basis of the lead time in an automated manner." (Column 1, line 64 through Column 2, line 3). An examination of the teachings of *Matoba* confirms that *Matoba* cannot be said to disclose, teach, or suggest the "lead request message" recited in Applicants' Claims 14-18. For at least these reasons, Applicants respectfully request reconsideration and allowance of Claims 14-18.

The Examiner rejects Claims 38 and 41-42 under 35 U.S.C. § 103(a) as being unpatentable over *Arledge* in view of *Matoba* and *Green*. Applicants respectfully request reconsideration of this rejection of Claims 38 and 41-42.

First, Applicants have shown above that the *Arledge-Green* combination does not recite each and every claim limitation of Claim 26, from which Claims 38 and 41-42 depend. Thus, Claims 38 and 41-42 are allowable for at least this reason.

Second, Applicants respectfully submit that in rejecting Claims 38 and 41-42 the Examiner has improperly performed what amounts to a "keyword rejection." For reasons similar to those discussed above with regard to Claims 14-18, the Examiner has taken the word "lead" as discussed in *Matoba* out of context and has improperly used *Matoba* to reject Applicants' claimed "lead data." For at least these reasons, Applicants respectfully request reconsideration and allowance of Claims 38 and 41-42.
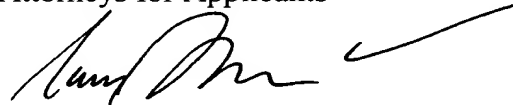
CONCLUSION

Applicants have made an earnest attempt to place this case in condition for allowance. For the foregoing reasons, and for other reasons clearly apparent, Applicants respectfully request full allowance of all pending claims.

If the Examiner feels that a telephone conference would advance prosecution of this Application in any manner, the Examiner is invited to contact Samir A. Bhavsar, Attorney for Applicants, at the Examiner's convenience at (214) 953-6581.

Although no fees are believed due, the Commissioner is hereby authorized to charge any fees or credit any overpayment to Deposit Account No. 02-0384 of Baker Botts L.L.P.

Respectfully submitted,
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